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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,268	01/26/2004	Kenichi Kitano	21581-00160-US3	6456

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EXAMINER

WU, IVES J

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No. 10/763,268	Applicant(s) KITANO ET AL.	
	Examiner Ives Wu	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-30, 38-49 and 51-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-49 is/are allowed.
- 6) ☒ Claim(s) 12-30 and 51-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1). Applicants' Remarks, Oath and Amendments filed on April 20, 2006 have been received and acknowledged.

Claims 12,13, 22, 38, 44, 51, 55, 56 are amended.

Claims 1-11, 31-37, 50 are previously canceled.

The 112nd paragraph rejections for claims 22-30 and 56 in the prior Office Action dated December 20, 2005 is withdrawn in response to the Applicants' Amendments filed on April 20, 2006.

However, the rejections of claims 12-30 and 51-56 in the prior Office Action dated December 20, 2005 are sustained.

Claim Rejections - 35 USC § 102/103

(2). The text of those Section Title 35 U. S. Code not included in this Office Action can be found in the prior Office Action dated December 20, 2005.

Claims 12-30, 52-56 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kusakabe et al (US005986014) for the same rationale recited in prior Office Action dated December 20, 2005.

Claim 51 is rejected under 35 U.S.C. 102(e) as being anticipated by Kusakabe et al (US005986014) for the same rationale recited in prior Office Action dated December 20, 2005.

Allowable Subject Matter

(3). Claims 38 - 49 are allowed.

Response to Arguments

Applicant's arguments filed on April 6, 2006 have been fully considered but they are not persuasive.

(4). Applicants argue that the prior art reference of Kusakabe et al (US005986014A) does not disclose the alkenyl group according to the formula (1) claimed by applicants where oxygen

Art Unit: 1713

atom is directly bonded to a carbon atom having R^1 , R^2 derived from the group bonded to a vinyl group of vinyl monomer, or the structures according to formula (5) and (6) as presently claimed, in which a carbon group having an electron-withdrawing group (at least one of R^6 and R^7) is directly bonded to a carbon atom having R^1 , R^2 derived from the group bonded to a vinyl group of vinyl monomer. However, the formula (1) of claim 12, in which the R^1 and R^2 can both be hydrogen (not a univalent organic group derived from the group bound to a vinyl group of a vinyl monomer) so that the partial structure of formula (2) of Kusakabe et al (US005986014A) meets the requirements of the claim 12. Same condition applied to the R^1 and R^2 of formula (5) and (6).

(5). Applicants' Statement of Common Ownership indicates that both the application and U.S. Patent 5986014 are commonly owned by Kaneka Corporation at time the invention of this application was made. However, the rejection is in effect an obviousness-type rejection under 35 USC 103 (C), because according to MPEP 2146, Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) was disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Here, both the filing date and date of patent of prior art - Kusakabe et al US005986014A are before the November 29, 1999. Therefore, the OATH will not affect the ground of rejection in the prior Office Action dated December 20, 2005.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1713

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ives Wu whose telephone number is 571-272-4245. The examiner can normally be reached on 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner: Ives Wu
Art Unit: 1713
Date: June 9, 2006



DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700